

REMARKS

Claims 1 to 3, 5 to 11, 14 to 21, and 23 to 26 remain pending. Claims 1 to 3, 5 to 11, and 14 to 20 have been withdrawn.

Claims 21 and 24 to 35 have been rejected under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement. The Action stated that the members of the broad genus PPAR stabilizers were only described in the specification by general function. The Action further stated there was no description of common structure and that only one species, perilla oil, was disclosed.

The rejection of claims 21 and 24 to 35 under 35 U.S.C. 112, first paragraph, for lack of written description is overcome in view of the amendment of independent claims 21 and 35 to the application of perilla oil. The Action appears to mischaracterize the rejection as being under first paragraph, which refers to enablement, when it probably should have been made under the second paragraph, which refers to description. Response herein to that reject presumes it was made under the second paragraph in view of the substance of the supporting assertions provided in the Action.

Claims 21 and 24 to 35 have been rejected under 35 U.S.C. 112, first paragraph, for non-enablement. The Action admitted the specification was enabling for a method of topically applying perilla oil. The Action also stated that the specification was not enabling for PPAR stabilizers.

The rejection of claims 21 and 24 to 35 under 35 U.S.C. 112, first paragraph, for non-enablement is overcome in view of the

amendment of independent claims 21 and 35 replacing the PPAR stabilizer with a perilla oil.

Claims 21, 24 to 26, and 32 to 35 have been rejected under 35 U.S.C. 112, second paragraph, for failure to comply with the written description requirement. The Action stated that the terms "means" and "method" appear to be used interchangeably in the claims.

The rejection of claims 21, 24 to 26, and 32 to 35 under 35 U.S.C. 112, second paragraph, for lack of written description have been overcome in view of the amendments to dependent claims 24, 25, 26, 33, and 34 deleting the term "method" and inserting the term "means." The terms are now distinguishable.

Claims 21 to 28 and 30 to 35 have been rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 7-187989 to Miyazaki et al. (Miyazaki). The Action states that the abstract of Miyazaki discloses a cosmetic preparation for the skin having 1% of perilla extract to be used for whitening the skin and preventing sunburn. The Action also stated that the method comprised topically applying perilla oil to the skin. The Action also stated that reduction in oil production by sebaceous glands, lipid and triglyceride synthesis in adipose tissue, and amelioration of cellulite and acne was inherent to the method and composition disclosed in the abstract of Miyazaki.

The rejection of claims 21 to 28 and 30 to 35 under 35 U.S.C. 102(b) over the abstract of Miyazaki are not well taken because the disclosure of the abstract of Miyazaki bears no relationship to claimed method. The abstract of Miyazaki states "The Perilla extract is used as a melanin generation inhibitor and cosmetic for whitening the skin (claimed). The melanin

generation inhibitor is used for prevention of pigmentation and sunburn and for whitening the skin." (see second page, middle) The Action then asserts that the claimed means of reduction in oil production by sebaceous glands, lipid and triglyceride synthesis in adipose tissue, and amelioration of cellulite and acne was inherent to the method and composition disclosed in the abstract of Miyazaki. The Action provides no basis whatsoever for this assertion. The Action establishes no basis for a nexus between skin whitening and any of the delineated means, such as reduction in oil production. Thus, inherency has not been properly established between the claimed method and the disclosure of the abstract of Miyazaki. On its face, skin whitening bears no direct functional relationship to any of the delineated means in claim 21. Thus, the rejection of claims 21 to 28 and 30 to 35 under 35 U.S.C. 102(b) over the abstract of Miyazaki is improper and should be withdrawn.

Claims 21 to 26 and 32 to 35 have been rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 8-119829 to Kondo et al. (Kondo). The Action stated that the abstract of Kondo discloses an external skin preparation having perilla oil to be used for xerosis and dry skin. The Action also stated that the method comprised topically applying perilla oil to the skin. The Action further stated that reduction in oil production by sebaceous glands, lipid and triglyceride synthesis in adipose tissue, and amelioration of cellulite and acne are inherent to the method and composition disclosed in the abstract of Kondo.

The rejection of claims 21 to 26 and 32 to 35 under 35 U.S.C. 102(b) over the abstract of Kondo is not well taken because the disclosure of the abstract of Kondo bears no relationship to the claimed method. The abstract of Kondo states "...external medicine for skin which can prevent skin inflammation

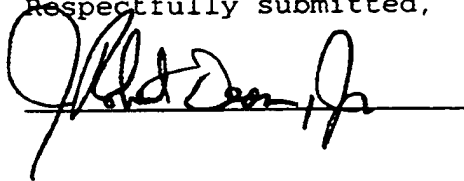
drying and shows excellent amelioration against xerosis or symptoms corresponding thereto, so called dry skin." The Action then asserts that the claimed means of reduction in oil production by sebaceous glands, lipid and triglyceride synthesis in adipose tissue, and amelioration of cellulite and acne was inherent to the method and composition disclosed in the abstract of Miyazaki. The Action provides no basis whatsoever for this assertion. The Action establishes no basis for a nexus between preventing skin inflammation drying or amelioration against xerosis or dry skin and any of the delineated means, such as reduction in oil production by sebaceous glands. Thus, inherency has not been properly established between the claimed method and the disclosure of the abstract of Kondo. On its face, preventing skin inflammation drying or amelioration against xerosis or dry skin bears no direct functional relationship to any of the delineated means in claim 21. Thus, the rejection of claims 21 to 26 and 32 to 35 under 35 U.S.C. 102(b) over the abstract of Kondo is improper and should be withdrawn.

Claim 29 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki. The Action stated that the abstract of Miyazaki is deficient because it discloses an amount lower than the amount range of PPAR stabilizer. The Action also stated that the claimed amount of PPAR stabilizer has not been established as critical. The Action further stated that since Miyazaki discloses that perilla oil is an effective agent when topically applied to the skin, the claimed method was *prima facie* obvious.

The rejection of claim 29 under 35 U.S.C. 103(a) over Miyazaki is not well taken in view of the remarks presented above in the rejection of claim 21, from which claim 29 depends, under 35 U.S.C. 102(b) over the abstracts of Miyazaki and Kondo.

Reconsideration of claims 1 to 3, 5 to 11, 14 to 21, and 23 to 26 is deemed warranted in view of the foregoing. Allowance of said claims is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Robert Dean, Jr.", is written over a horizontal line.

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